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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,219	12/18/2000	Alejandro Wiechers	10001310-1	3213

7590 08/10/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2171

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/747,219	WIECHERS, ALEJANDRO	
	Examiner	Art Unit	
	Susan Y Chen	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/21/00, 09/30/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-20 are presented for examination.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law or nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve use, or advance the technological arts.

In the present case, claims 1-20 merely recite an abstract network assembly operational procedure, which is not implemented in any tangible form, or produce a useful, concrete and tangible result. The claimed program code and method only consist of the arrangement of fact or data on a storage media without any object. As such, these claims are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1, 15 and 20, these claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential functional cooperative relationship of elements, such omission amounting to a gap between the claimed subject matters – the reference repository, the index unit and the editing unit as unclear functional objects. Therefore, these claims are indistinct.

As to claims 2-14 and 16-19, these claims have the same defects as their base claims, hence are rejected for the same reason.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (U.S. Patent No. 6,311,214).

As to claims 1-5, Rhoads discloses a network assembly processing system, comprising:

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a) a reference repository [e.g., the bedoop registry (34), Fig. 2; col. 3, lines 5-7], wherein, the reference repository receives the electronic file from the communication network including Internet [e.g., the network 18; Fig. 1; col. 2, line 66] and stores the characteristic information associated with the electronic file [col. 4, lines 5-11]. Rhoads further discloses that the electronic file comprises published material [e.g., the published Magazines, the Web page; col. 4, lines 19-26; col. 11, lines 37-40; col. 15, lines 15-35].

b) an indexing unit linked with the reference repository [e.g., the master registration server, the class servers (48a-c), Fig. 2; col. 14, lines 56-60];

c) an editing unit linked with the reference repository and the indexing unit [e.g., the editing tools at col. 10, lines 18-26].

As to claims 6-7, except all the restrictions cited in claim 1, Rhoads further discloses that the indexing unit assigns and stores an identification code to the electronic file respect to the associated characteristic data [e.g., col. 11, lines 20-44].

As to claim 9, except all the restrictions cited in claim 1, Rhoads further discloses that the identification code comprises a set of specific identification code [e.g., the class, DNS and UID of a Bedoop code, col. 10, lines 30-32].

As to claim 10, except all the restrictions cited in claim 1, Rhoads further discloses that the editing unit inserts the identification code to the electronic file [e.g., col. 11, lines 1-8; col. 31, lines 38-49].

As to claim 11, except all the restrictions cited in claim 1, Rhoads further discloses that the editing unit formats the identification code with respect to the electronic file [e.g., see the section Data structures, Formats, Protocols, and Infrastructures section at col. 7 – col. 9; col. 30, lines 41-43; col. 32, lines 30-39].

As to claim 12, except all the restrictions cited in claim 1, Rhoads further discloses that the system comprises a review unit linked with the indexing unit [e.g., the DNS Servers (50), Fig. 2].

As to claims 13-14, except all the restrictions cited in claim 12, Rhoads further discloses that the review unit dispatches the formatted electronic file from the network assembly to a client [e.g., col. 9, lines 3-23].

As to claims 15-20, these claims recite the same subject matters as claims 1-14 in form of computer program product and method, hence are rejected for the same reason.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Rhoads (U.S. Patent No. 6,542,927) which discloses the use of steganographically encoded digital data to link corresponding object which are

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distributed on computers via internet; Rodriguez et al. (U.S. Patent No. 6,650,761) which discloses a system to digitally watermark business cards and methods; Calamera et al. (U.S. Patent No. 6,463,533) which discloses a system for allowing a computer network site to recognize an anonymous user without revealing the identify of the user; Saigh et al. (U.S. Patent No. 6,633,877) which discloses a digital library distribution system to delivery the selected electronic files to a client in the Internet.

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on Monday - Friday from 7:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2171

July 29, 2004


UYEN LE
PRIMARY EXAMINER